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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,650	12/29/2000	Peter M. Dickstein	05284-P001	1500

20872 7590 12/29/2006  
MORRISON & FOERSTER LLP  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

EXAMINER
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KESACK, DANIEL

ART UNIT	PAPER NUMBER
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3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/752,650	<b>Applicant(s)</b> DICKSTEIN ET AL.	
	<b>Examiner</b> Dan Kesack	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 6/30/06.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 79-84, 87-90, 95-97, 99-102, 104, 106, 108, 109 and 112-130 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 79-84, 87-90, 95-97, 99-102, 104, 106, 108, 109, 112-130 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. Amendment filed June 30, 2006 has been entered and fully considered. Claims 79-84, 87-90, 95-97, 99-102, 104, 106, 108, 109, 112-130 are currently pending. The rejections are as stated below.

#### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 79-83, 87-90, 95-97, 99, 104, 108, 109, 112-116, 118-123, 127, 129 and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cristofich et al., U.S. Patent No. 6,269,346, in view of SEC EDGAR Submission 0001012870-98-001814, hereinafter SEC2, already of record.

4. Claims 79, 82, 83, 95, 96, 108, 112, 115, 116, 121, 122, 129, Cristofich teaches a system and method for managing a plurality of stock option accounts. Examiner notes that a change in stock ownership inherently changes a company's equity ownership and that any buying or selling of a security related to a company is regarded as a capitalization structure-affecting event. Therefore, Cristofich teaches initiating a

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capitalization structure affecting request using an input device (column 8 lines 25-26), automatically determining a vesting schedule particular for the person in response to said request, using software in communication with the input device (column 8 lines 38-54), wherein determining the schedule includes accessing company restrictions (column 5 lines 58-65), accessing a record of the person (column 6 lines 20-26), and accessing governmental restrictions (column 5 lines 1-5, and column 7 lines 15-51). While Cristofich does not explicitly teach accessing governmental restrictions, the teaching is inherent because the IRS and SEC rules and regulations are consulted and followed, and therefore must be accessed. Furthermore, Cristofich teaches classifying the request by accessing company restrictions, person records, and governmental restrictions (column 15 lines 13-30), wherein the automatically determined vesting schedule is the actual fulfillment of the capitalization structure affecting request, and the records of the person stored at the database are updated (column 8 lines 38-62).

Cristofich fails to teach automatically updating the company's complete equity ownership structure, including the ways the company is funded and the associated ownership by employees, investors, and lenders.

SEC2 teaches a disclosure of a company's equity ownership structure, including the ways the company is funded and the associated ownership by employees, investors, and lenders (p 9, 10, 29-34). As cited in the previous Office Action, it is old and well known to maintain updated records, at least because records concerning capitalization and personnel are necessarily kept up to date according to generally accepted accounting principals (It is noted that since Applicant did not adequately

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traverse Examiner's assertion of what is old and well known, it is taken to be admitted prior art). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Cristofich to include automatically updating the company's complete equity ownership structure because such records are required to be maintained, and the option exercising of Cristofich would change said structure.

Claims 80, 104, 113, 127, Cristofich teaches at least buying and selling of company securities and exercising options (column 4 lines 51-64).

Claims 81, 114, Cristofich teaches hypothetical "what-if" requests (column 12 lines 63 – column 14 line 4).

Claims 87, 97, 118, 123, Cristofich teaches interfacing with the administration software by network (column 3 line 49 – column 4 line 33)

Claims 88, 119, Cristofich teaches the use of a transfer agent (column 4 lines 22-34).

Claims 89, 99, Cristofich teaches the system being used by employees of companies who receive stock options as compensation (column 1 lines 20-31).

Claims 90, 120, Cristofich teaches initiating an exercise of options on behalf of a person by the system, which is considered an authorized agent (column 8 lines 55 – column 9 line 19).

Claims 109, 130, Cristofich teaches providing a granted or pending status for the transaction request (column 10 lines 60-65, column 12 lines 14-24, column 16 line 22).

5. Claims 84, 100, 106, 117, 124, and 128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cristofich et al., and SEC2, in view of Dictionary of Finance and Investment Terms, hereafter Dictionary, already of record.

Cristofich and SEC2 fail to teach company restrictions including approval status of a board of directors, and being limited to a type of transactions based on an employee's position.

Dictionary teaches a board of directors approving the issuing of additional shares (p 57). Furthermore, Dictionary describes restrictions placed on the shares received by board members. It would have been obvious to modify the teachings of Cristofich and SEC2 to include these teachings because Cristofich teaches reviewing restrictions as part of the granting process, and the board of director approval would provide oversight of capitalization of the company.

6. Claims 101, 102, 125, and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cristofich et al., and SEC2.

Cristofich fails to teach a customized user interface used to pay for and track payment particulars related to security transaction requests.

In the Office Action dated February 2, 2006, Examiner took official notice of the fact that payment screens in user interfaces were old and well known in the art at the time of the Applicant's invention. Applicant's failure to adequately traverse Examiner's Official Notice is taken to be admitted prior art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Cristofich to include a user interface with payment and tracking screens because such an interface would allow a user to more easily and efficiently submit and confirm requests to exercise options, as described by Cristofich.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 79-84, 87-90, 95-97, 99-102, 104, 106, 108, 109, 112-130 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HANI M. KAZIMI  
PRIMARY EXAMINER